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EXAMINER

EDWARDS, LAURA ESTELLE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. JACOBSON and
RUSSELL P. HAZARD

Appeal 2008-3155
Application 09/808,584
Technology Center 1700

Decided: September 29, 2008

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's refusal to allow claims 1-9, 19-24, 29-35, and 57 as amended subsequent to the final rejection (*see* the amendment dated Jan. 18, 2006, entered as per the Advisory Action dated Jan. 31, 2006; App. Br. 6).¹

¹ We refer to and cite from the "SUBSTITUTE APPEAL BRIEF" dated Apr. 16, 2007.

The remaining claims in this application are claims 10-18, 25-28, and 58-61. Claims 58-61 have been allowed and claims 10-18 and 25-28 were objected to (App. Br. 5; Final Office Action dated Nov. 18, 2005, p. 5). We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to a coating apparatus in which a metering bar exerts a force against an applicator, with the coating composition present in a nip formed by the metering bar and the applicator (App. Br. 7). Further details of the invention may be gleaned from illustrative independent claim 1 as reproduced below:

1. An apparatus for coating an article, said apparatus comprising:
 - an applicator;
 - a conveyor for sequentially transporting a plurality of articles to said applicator; and
 - a metering bar comprising a fixed arcuate end positioned against said applicator to meter a predetermined amount of coating composition to said applicator for transfer to an article transported to said applicator by said conveyor,
 - said metering bar forming a nip with said applicator and exerting a force against said applicator,
 - said predetermined amount of coating composition being determined, in part, by said force of said metering bar and a hydraulic force present at said nip.

The Examiner has relied on the following prior art references as evidence of obviousness:

Jonkers	4,299,164	Nov. 10, 1981
Jaffa	5,501,147	Mar. 26, 1996

Kirk-Othmer, *Encyclopedia of Chemical Technology*, 832-834, 4th ed., Vol. 20, John Wiley & Sons, 1996.

ISSUES ON APPEAL

Claims 1-9, 19-24, 29-31, 35, and 57 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jonkers in view of Jaffa (Ans. 3).

Claims 32-34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jonkers in view of Jaffa and Kirk-Othmer (Ans. 5).²

Appellants contend that the Examiner asserts that element 3 of Jonkers is an “applicator roll” but actually element 3 is a stencil, and a stencil is a sheet with openings through which ink can pass (App. Br. 10-11; Reply Br. 1).

Appellants contend that the dye paste of Jonkers is not metered to the stencil, but is pressed directly from the squeegee to the web. Appellants further contend that the Examiner admits that the squeegee, not the stencil, of Jonkers meters a coating material to the web, and thus the stencil is not an applicator to which a coating composition is metered (App. Br. 11).

Appellants present separate contentions for dependent claims 2, 8, 9, and independent claim 57 (App. Br. 11-15; Reply Br. 2-3).

The Examiner contends that claim 1 does not exclude the applicator from being a screen or stencil type roller applicator, and Jonkers discloses a stencil roller through which a coating material is metered via metering bar 4 for transfer onto a web or sheet (Ans. 6). The Examiner relies on Jaffa as evidence of the conventional use of conveyors to move web or sheet material to metering stations (Ans. 3-4).

² We note the Decision mailed Mar. 21, 2005, in an earlier appeal (Appeal No. 2004-1912) in this application, where all rejections were reversed. However, we also note that the claims in that appeal were different from the present appeal, as is the prior art cited against the claims.

From the record presented in this appeal, we determine the following issues presented in this appeal: (1) have Appellants established that the Examiner committed reversible error in the claim construction of claim 1 on appeal; and (2) if claim 1 is properly construed, have Appellants established that the Examiner committed reversible error in determining obviousness over the reference evidence?

We determine that the Examiner has properly construed claim 1 on appeal, and also properly established a prima facie case of obviousness in view of the reference evidence. We also determine that Appellants' arguments have not adequately rebutted this prima facie case. Therefore, we sustain the Examiner's rejections essentially for the reasons stated in the Answer, as well as those reasons set forth below. The decision of the Examiner is thus AFFIRMED.

OPINION

We determine the following Findings of Fact (FF) from the record presented in this appeal:

- (1) Jonkers discloses a squeegee structure for a rotary screen printing machine where the brushing edge 4 at the end of the squeegee presses a dyepaste through a stencil for printing a web of material (Ans. 3; Jonkers, Figs. 1-6; col. 1, ll. 5-13; col. 3, l. 1);
- (2) Jonkers teaches that the tip of the squeegee forms a nip angle with the stencil, and the amount of coating composition (dyepaste) delivered to the web depends on this nip angle as well as the contact pressure of the squeegee upon the stencil (Ans. 3; Jonkers,

col. 1, l. 40-col. 2, l. 8; col. 3, ll. 1-42; col. 4, ll. 11-14 and 19-22).³

During *ex parte* prosecution before the Examiner, the claim language is given the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise may be afforded by Appellants' specification. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). "[P]articulate embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments." *Electro Med. Sys. S.A. v. Cooper Life Sciences Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994). The PTO should only limit the claim based on an express disclaimer of a broader definition. See *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). A patent applicant is free to recite features of an apparatus either structurally or functionally. "Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). Where the PTO has reason to believe that a functional limitation asserted to be critical may in fact be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter in the prior art does not possess the characteristic relied on. *Id.*, quoting *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the

³ We do not list any Findings of Fact from Jaffa and Kirk-Othmer since Appellants do not contest or dispute any of the Examiner's factual findings from these two prior art references (e.g., App. Br. 15-16). Therefore, we adopt the Examiner's Findings of Fact from the Answer (Ans. 3-4 and 5-6).

differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations, if any. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Accordingly, we first must correctly construe the claims to define the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). Appellants contend that claim 1 does not recite “an applicator through which coating material is metered” (Reply Br. 1, emphasis in original). Appellants also contend that the stencil (element 3) of Jonkers is not an applicator to which a coating composition is metered and from which the coating composition is transferred to an article (App. Br. 11). Therefore, we first must correctly construe the claimed word “applicator” (*see* claim 1 on appeal). We do not find this word modified in any manner in claim 1 on appeal, with only a broad recitation of “an applicator.” *Id.* We also determine that Appellants have not pointed to any definition or guidelines in their Specification for interpreting this word, and we do not find any definition of this word in Appellants’ Specification. Accordingly, we resort to a dictionary definition consistent with the use of this word in the Specification (e.g., Spec. 1:29; 5:17; and 7:22-8:9). *See Phillips v. AWH*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). An “applicator” is defined as “a device for applying a substance,” while “applying” is defined as “to lay or spread on.”⁴ Giving this word its broadest reasonable meaning consistent with its ordinary usage, we determine that an applicator is any device that lays or spreads a substance upon another material or substrate. We do not find that Appellants have expressly disclaimed a broader definition that an applicator can include a screen, stencil, or sieve.

⁴ *Webster’s New Collegiate Dictionary*, p. 55 (G. & C. Merriam Co. 1977).

Accordingly, we determine that the stencil disclosed by Jonkers delivers or lays material onto the web material below it (*see* FF (1)), and thus constitutes an applicator within the ordinary meaning of that word.

With regard to the functional language recited in claim 1 on appeal, we determine that “to meter a predetermined amount of coating composition to said applicator for transfer to an article transported to said applicator by said conveyor” does not distinguish over the structure disclosed by Jonkers. First, we determine that the metering bar disclosed by Jonkers (element 4) is *capable* of achieving this function set forth by the language of claim 1 on appeal. *See In re Schreiber, supra*. Secondly, as shown by FF (2) listed above, we determine that the metering bar (element 4) disclosed by Jonkers does accomplish the function required by claim 1 on appeal, namely the nip angle and contact pressure of the squeegee against the stencil (i.e., the force exerted against the applicator) determine the amount of coating composition delivered to the applicator (stencil) for transfer to the web below.

In view of our claim construction discussed above, we agree with the Examiner that Jonkers discloses the apparatus as recited in claim 1 on appeal, with the conventional use of a conveyor for moving the articles to be coated, as evidenced by Jaffa (Ans. 3-4). As discussed above, Appellants do not contest or dispute the Examiner’s findings of fact regarding Kirk-Othmer as applied against claims 32-34, and thus we adopt these findings and conclusion of law as stated by the Examiner. Ans. 5-6.

With regard to Appellants’ contentions for claims 2, 8, 9, and 57 (App. Br. 11-15; Reply Br. 2-3), we do not find these arguments persuasive for reasons stated in the Answer (Ans. 4-5), as well as below.

With regard to claims 9 and 57, both of these claims require the applicator to be in the form of a “roller.” Appellants argue that the squeegee of Jonkers is not a roller (Reply Br. 3). However, this argument is not relevant since the Examiner finds that the stencil (element 3) of Jonkers is the applicator, as discussed and construed above. The Examiner has also found that it was “well known and conventional” in the coating art that a rotary screen printing apparatus as disclosed by Jonkers includes a rotary screen or rotary applicator, i.e., an applicator roller. Ans. 7. Appellants have not argued, much less established, that the Examiner committed reversible error in this finding.

With regard to claim 2, where the roller has a specified hardness, Appellants argue that Jonkers does not teach or suggest that his stencil should have any particular hardness (App. Br. 12; Reply Br. 2). This argument is not persuasive since Jonkers does suggest that the hardness of the cooperating parts of his device is important. As disclosed by Jonkers, the part of the squeegee contacting the stencil must have a low coefficient of friction and a high resistance to wear, i.e., it must have a hard and smooth surface (col. 1, ll. 11-13 and 52-56). Jonkers teaches that proper operation of the squeegee in a screen printing machine requires that part of the squeegee cooperates with the stencil at a reduced or low friction (col. 1, ll. 24-26). Therefore, we determine that one of ordinary skill in this art would have easily determined the hardness of the stencil to avoid undue wear and resistance during the operation of the squeegee across the face of the stencil. “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative

steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007).

With regard to claim 8, Appellants argue that Jonkers does not suggest or teach coating the edge face of a tape as required by this claim (App. Br. 14; Reply Br. 2). However, as discussed above, Appellants run a risk when using functional language such as the recitation set forth in claim 8 that the conveyor and applicator are “configured to enable” coating of the edge face of a roll of tape. We find no reason in the record that the apparatus disclosed by Jonkers in combination with Jaffa would not be capable of coating the edge face of a roll of tape. *In re Schreiber, supra*. We determine that Jonkers teaches coating a “web of material” (col. 1, ll. 5-8; claim 1), and one of ordinary skill in this art would have recognized that this web of material could have included tapes or other faces of material.

For the foregoing reasons and those stated in the Answer, we affirm the decision of the Examiner.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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